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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/106,858	06/30/1998	ARIE M. WIJNEN	9655-0001-2	7286

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EXAMINER

MCCHESNEY, ELIZABETH A

ART UNIT PAPER NUMBER

2644

DATE MAILED: 01/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/106,858

Applicant(s)

WIJNEN ET AL.

Examiner

Elizabeth A McChesney

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

1. Claims 1, 3-9 and 11-20 are now pending in the present application.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. **Claim 1** is rejected under 35 U.S.C. 112, second paragraph, as the method is only one step wherein the one step does not in itself constitute copy protection. In the interpretation of the claim for examining purposes no weight can be given to the preamble, as the step on its own does not do copy protection. Copy protection is an entire scheme with multiple steps and actions that goes to an apparatus or device for actual copy protection. The limitation of the method pertaining to copy protection is not justified by what is in the body of the claim.

**Claim 8** is rejected under 35 U.S.C. 112, second paragraph, as just storing an audio signal on a recording medium and mixing audio signal with a non-audible signal cannot be given weight in itself as to constitute copy protection.

**Claim 9** is rejected under 35 U.S.C. 112, second paragraph, as generating a non-audible signal and mixing with audio signal cannot be given weight in itself as to constitute copy protection.

**Claim 18** is rejected under 35 U.S.C. 112, second paragraph, as mixing in a non-audible signal, either low-frequency or high frequency cannot be given weight in itself as to constitute copy protection functionality.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claim 1 and 8-9** are rejected under 35 U.S.C. 102(b) as being anticipated by Kahn (US Patent No. 5,394,274).

Regarding **claim 1**, Kahn discloses an anti-copy system utilizing audible and inaudible protection signals in which uses steps in which an inaudible protection signal 102 is mixed with an audio program source (see figure 1 and col. 5-lines 55-60) and which coincides with the claimed limitation.

Regarding **claim 8**, it is interpreted and thus rejected for the same reasons as set forth above in claim 1. Since claim 8 discloses an apparatus, which corresponds to, the method of claim 1; the apparatus is obvious in that it is simply provides a structure for the functionality of claim 1.

Regarding **claim 9**, it is interpreted and thus rejected for the same reasons as set forth above in claim 1. Since claim 9 discloses an apparatus, which corresponds to, the method of claim 1; the apparatus is obvious in that it is simply provides a structure for the functionality of claim 1.

***Response to Arguments***

Art Unif: 2644

6. Applicant's arguments filed 10/23/02 have been fully considered but they are not persuasive. Upon further examination of the independent claims, the body of the claim does not in itself constitute copy protection. The claims are extremely broad wherein mixing non-audible signals with audio signals of different frequencies can be used in many different well known procedures and techniques, for example, to name a few, data identification, market research, commercial verification, hidden data, etc. Therefore the examiner's original reference is maintained as Kahn does mix an inaudible signal with an audio signal. The coinciding dependent claims cannot not be weighted as a result.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Streeter (US Patent No. 4,332,978) discloses low frequency AM stereophonic broadcast and receiving apparatus.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. McChesney whose telephone number is (703) 308-4563. The examiner can normally be reached Monday – Friday, 8:00 am – 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on (703) 305-4386.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Art Unit: 2644

Washington, D.C. 20231

**Or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

EAM *EAM*  
January 8, 2003



FORESTER W. ISEN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600